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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/738,444	12/15/2000	William E. Jack	NEB-180	9633

28986 7590 07/11/2002
NEW ENGLAND BIOLABS, INC.
32 TOZER ROAD
BEVERLY, MA 01915

EXAMINER

LU, FRANK WEI MIN

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 07/11/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09738,444

Applicant(s)

W.E. JACK, et al.

Examiner

Frank Lu

Group Art Unit

1634

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-5, 22-29 is/are pending in the application.
- ☐ Of the above claim(s) 6-13, 19-21 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-5, 22-29 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Other Detailed Action

Office Action Summary

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DETAILED ACTION

Response to Amendment

1. IDS and applicant's response to the office action and filed on April 29, 2002 has been entered as Paper Nos: 6 and 7. The claims pending in this application are claims 1-13 and 19-29 with claims 6-12 and 19-21 withdrawn from consideration as the result of the restriction requirement.

Election/Restriction

2. Applicant's election without traverse of Group I, claims 1-5 and 14-18 in Paper No. 7 is acknowledged.

3. After reviewing newly added claims 22-29, restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to a method for creating a target single-stranded region in double-stranded DNA, classified in class 435, subclass 6.
- II. Claims 22-29, drawn to a nucleic acid molecule, classified in class 536, subclass 23.1.

4. The inventions are distinct, each from the other because of the following reasons:

Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, that

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the product as claimed can be made by another and materially different process such as the method taught by Wang *et al.*, (Molecular Biotechnology, 15, 97-104, June 2000). For the product in claim 22, see substrate in Figure 2 A.

Note that Group II contain 32 different nucleotide sequences (SEQ ID Nos: 16-32 and SEQ ID Nos: 35-49). The applicant is hereby required to select a single sequence for examination from these SEQ ID Nos.

By statute, "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." 35 U.S.C. 121. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant . . . to elect that invention to which his claim shall be restricted." 37 CFR 1.142(a). See also 37 CFR 1.141(a).

Nucleotide sequences encoding different proteins or nucleotide sequences with different base sequences are structurally distinct chemical compounds and generally, are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 *et seq.* Applicant is advised that examination will be restricted to only elected SEQ ID NO. and should not to be construed as a species election.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (703) 305-1270. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the patent Analyst of the Art Unit, Ms. Chantae Dessau, whose telephone number is (703) 605-1237.



Frank Lu
July 2, 2002